

REMARKS

Applicants submitted an Amendment and Response on December 9, 2004 in reply to the first Action mailed on September 9, 2004. This paper was deemed non-compliant because the claims are allegedly not provided with the proper status identifier. In a teleconference between the undersigned attorney and the Examiner, it was determined that the Patent Office staff has failed to consider the amendments previously made to the claims via the Preliminary Amendment filed on June 14, 2001. The Examiner invited the undersigned to memorialize this in a written response to the Notice of Non-Compliant Amendment. Applicants subsequently submitted a paper on May 6, 2005 directing the Patent Office's attention to the Preliminary Amendment identified above. In a follow up teleconference between the undersigned and the Examiner, it was determined that in view of the submission of January 29, 2002, which included a copy of the original claims attached to the executed Oath and Declaration, the preliminary amendment had not been entered. Applicants thus submit the present amendment, which includes both the amendments submitted via the preliminary amendment of June 14, 2001 as well as the amendments presented in the response submitted on December 9, 2004. The arguments and comments previously made in this response are reproduced herein.

Claims 1 – 19 are currently pending in the application, and claims 1-5 and 8-19 stand rejected.

Objections to the drawings

The drawings are objected to as failing to comply with 37 CFR 1.83(a). Applicants have amended the claims and submit that the drawings show every feature of the inventions as now recited in the amended claims.

Claim Objections

Claims 6 and 7 stand objected to because claim 6 is a multiple dependent claim and claim 7 is dependent thereon. Applicants invite the Examiner's attention to the Preliminary Amendment filed concurrently with this application, wherein claim 6 was amended to depend solely from claim 1, and request the Examiner to withdraw this objection.

Claim 9 is objected to for using improper English. Applicants respectfully submit that this is not the case. However, in the interest of passing this case to issue, Applicants have amended claim 9 to make it clearer. Applicants expressly note that this amendment is not made for purposes related to patentability, but solely to make it clearer in view of the Examiner's comments.

Rejection under 35 U.S.C §112

Claims 1-10 stand rejected under 35 U.S.C. 112 as failing to comply with the enablement requirement. In particular, the Examiner asserts that the limitations "location-data input manager," "input manager," "input subsystem" and "output subsystem" are not found in the specification. These terms have been replaced with "location server" and Applicants thus submit that this rejection has now been obviated.

Rejection under 35 U.S.C §103

Claims 1-5 and 8-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,748,426 to Shaffer et al. in view of U.S. Pat. No. 6,738,841 to Wolff and U.S. Pat. No. 6,115,132 to Nakatsuma et al. In particular, the Examiner finds that Shaffer teaches a memory, a location-data input manager and a network interface, all having the claimed attributes, by teaching "database" at, according to the Examiner, column 5, line 31 to column 6, line 2. The Examiner further finds that Wolff teaches a wireless interface and a location server, as claimed, at column 8, lines 48-68. The Examiner also finds that Nakatsuma teaches a location-data input manager at column 7, lines 34-60. The Examiner finally opines that it would have been obvious to the skilled person to combine Shaffer and Wolff because using a wireless link to a printer gives a user the mobility to print data in any area that the printer and/or printer server can accommodate, and that it would have been obvious to the skilled person to further combine Nakatsuma with the combined system of Shaffer and Wolff because it would be more efficient for a system to utilize a manager to manage the users that are connected to the network and to queue printing jobs from those users.

Applicants have reviewed the references with care, paying particular attention to the passages cited to by the Examiner, and are compelled to disagree with the Examiner's understanding of these references. Contrary to the Examiner's understanding, Wolff does not in fact teach a location server for responding to client requests received via the network interface to return location information comprising, or derived from, the location data stored in memory [emphasis added]. There is simply nothing in Wolff that can possibly be interpreted as teaching this feature and, should the Examiner persist in this opinion, Applicants respectfully request him to clearly and specifically point out exactly where Wolff discloses this feature in accordance with 37 C.F.R. 1.104(c)2.

Furthermore, "database" as recited in column 5, line 31 to column 6, line 2 of Shaffer is nowhere near as all-encompassing as the Examiner appears to believe. The entire paragraph cited by the Examiner is dedicated exclusively to teaching a "Linkage Key" and the sole mention of database is in conjunction with "a sequential number database to retrieve, or assign if not found, a unique sequential number that is the Linkage Key" (col. 5, ll. 55-57) and "multiple databases (standardizing an address containing a building number, pre-direction, street name, street type, street post direction, secondary unit type, secondary unit number, city name and state and then assigning the standardized address a DPC code)" (col. 5, ll. 58-63). Contrary to the Examiner's professed understanding, Shaffer makes no disclosure, mention, or hint of a location-data input manager for receiving location data via the wireless interface and storing it in the memory [emphasis added]. At most, Shaffer discloses that the DPC, which "is a geographical hierarchical code that at the 1 1-digit zip code level represents as single household or postal delivery address," "like other embodiments of a Linkage Key, is determined from an LKIPV or equivalent data items stored in a database or file via a determination process." (col. 5, ll. 40-45) There is nothing in Shaffer regarding receiving location data. Should the Examiner persist in this opinion, Applicants once again respectfully request him to clearly and specifically point out exactly where Shaffer discloses this feature in accordance with 37 C.F.R. 1.104(c)2.

The claims have been amended to remove recitations of "location-data input manager" and Applicants therefore submit that Nakatsuma, regardless of whether it teaches such an element or not, is now irrelevant. The functions of the location-data input manager is performed by the location server in the amended claims and, as shown above, these functions are not

disclosed by either of Shaffer or Wolff. Applicants submit that these functions are also not disclosed by Nakatsuma. Of course, should the Examiner disagree, Applicants respectfully request him to clearly and specifically point out exactly where Nakatsuma does so.

Applicants respectfully remind the Examiner of the requirements posited by MPEP 2143.03 that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” (emphasis added) The Examiner has not made, and indeed cannot make, a *prima facie* showing that even if combined as alleged by the Examiner, the three references would render the presently claimed invention. Applicants therefore submit that claim 3 is allowable and respectfully request the Examiner to reconsider and pass the claim to issue.

The above arguments are equally applicable to claim 1, and Applicants respectfully request the Examiner to pass this claim to issue as well.

Claims 2 and 3-10 depend from claim 1. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claim 3 as applicable to claim 1, Applicants submit that claims 2 and 3-10 are also allowable.

With regards to claim 11, in addition to the above arguments that are equally applicable to claim 11, Applicants note that there is no teaching in any of the cited references, together or alone, of any device or function operative to convert the location data it handles between a first form and a second form, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates. The Examiner alleges that Shaffer “teaches the input is operative to cause the form of the received location data to be converted from a first form to a second form prior to storage in said memory, one of the first and second forms being a semantic location form and the other a form based on geographic coordinates,” once again invoking col. 5, l. 31 to col. 6, l. 2. This is simply not correct. Shaffer mentions that among of the types of Linkage Keys used are keys formed of zip code and street address information, or of interleaved latitude and longitude coordinate pairs. There is simply no mention of (1) semantic

form location data, as read in view of Applicants' specification, or (2) converting any kind of location data from one form to another form. Shaffer teaches the determination of a Linkage Kay from location information contained in one or more databases, but does not teach the conversion of any such information from one form to another. Of course, should the Examiner persist in this opinion, Applicants respectfully request him to clearly and specifically point out exactly where Shaffer discloses this feature in accordance with 37 C.F.R. 1.104(c)2.

Claims 12-19 depend from claim 11. Therefore, in light of the above discussion of claim 11, Applicants submit that claims 12-19 are also allowable.

Regarding the prior art made of record by the Examiner but not relied upon, Applicants believe that this art does not render the pending claims unpatentable.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

A Notice of Change of Correspondence Address was previously filed.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

September 8, 2005

(Date of Transmission)

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(Name of Person Transmitting)



(Signature)

9/8/05

(Date)

Respectfully submitted,



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